



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/360,521	07/23/1999	SERGE RESTLE	05725.0446-0	4299
22852	7590	07/28/2004	EXAMINER	
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 1300 I STREET, NW WASHINGTON, DC 20005			WELLS, LAUREN Q	
			ART UNIT	PAPER NUMBER
			1617	

DATE MAILED: 07/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/360,521

Applicant(s)

RESTLE ET AL.

Examiner

Lauren Q Wells

Art Unit

1617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 June 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-47 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-47 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 1617

DETAILED ACTION

Claims 1-47 are pending. The Amendment filed 6/22/04, amended claims 1, 44-46, and added claim 47.

Per the interview and Applicant's persuasive arguments, the 35 USC 112 rejection in the previous Office Action is hereby withdrawn.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-32, 34-41 and 43-47 rejected under 35 U.S.C. 103(a) as being unpatentable over Decoster (6,451,747—relied upon as an English language equivalent of WO 97/46210).

The instant invention is directed toward a composition comprising a washing base comprising an anionic and amphoteric surfactant, wherein the ratio of amphoteric:anionic is greater than or equal to 0.1:1, and a conditioner system comprising at least one aminated silicone having an amine number greater than or equal to 0.5 meq/g, and a cationic polymer.

Decoster teaches detergent and conditioning hair care compositions comprising, in a cosmetically acceptable medium, a washing base and a conditioning system comprising at least one cationic polymer and a mixture of at least one amine silicone and a grafted silicone polymer. Exemplified is a composition comprising 14g lauryl ethersulfate of sodium (anionic surfactant, 14% of composition), 3.2g cocoylbetaine

Art Unit: 1617

(amphoteric surfactant, 3.2%), 1.05 g amino silicone, 0.1 g guar gum modified by chloride of 2,3-epoxypropyl trimethylammonium (cationic polymer, 0.1%), and water, wherein the ratio of amphoteric/anionic surfactant is 0.23. For cellulose ether derivatives containing quaternary ammonium groups, see Col. 6, lines 27-35. For cationic polysaccharides, see Col. 6, lines 49-56. For quaternary diammonium polymers of formula (a) of instant claim 35, see Col. 8, lines 16-26. For cationic polymers comprising 0.001-10% of the composition, see Col. 11, lines 1-5. For compounds of formula (I), formula (IV), and (II), and the limitations of claims 13-25 and 27-29, see Col. 17, line 4-Col. 19, line 16. For aminosilicones comprising 0.05-10% of the composition, see Col. 19, lines 17-21. For water or an aqueous alcoholic solution as the vehicle, see Col. 19, lines 22-24. For ethanol, isopropanol and butanol, see Col. 19, lines 24-25. For fragrances, preservatives, sequestering agents, thickeners, softeners, foam modifiers, dyes, and other adjuvants, see Col. 19, line 36-42. For a process for washing and conditioning keratin fibers, such as hair, see Col. 19, lines 62-67. The reference lacks an exemplification of the preferred aminated silicones and the amount of solvent.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to substitute the amodimethicone exemplified in Decoster for the compounds of Formulas (I), (IV) or (II) of the instant invention because Decoster teach these compounds as interchangeable aminated silicones for use in his compositions.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to teach the solvents of Decoster as comprising 0.1-20% of the composition because it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only

Art Unit: 1617

routine skill in the art (*In re Aller*, 105 USPQ 233) and because Decoster teaches his compositions in a variety of forms, such as liquids more or less thickened, creams and gels; thus, one of skill would be motivated to alter the amount of solvent in the composition to achieve specific composition forms.

The recitations "detergent and conditioning cosmetic" in claim 1, and "for cleaning or removing make-up from keratinous substances, or for conditioning keratinous substances" in claim 44 have not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

Claims 33 and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Decoster as applied to claims 1-32, 34-41 and 43-47 above, and further in view of Naito et al. (5,476,649).

Decoster is applied as discussed above. The reference lacks 18-methyl-eicosanoic acid and polyalkylene glycols.

Naito et al. teach 18-methyl-eicosanoic acid as a branched fatty acid that imparts excellent conditioning effects to the hair and prevents the hair from being damaged, see abstract and Col. 1, lines 54-67. Polyalkylene glycols are taught as hair care ingredients that impart moisturization and flexibility to the hair.

Art Unit: 1617

It would have been obvious to one of ordinary skill in the art at the time the invention was made to add 18-methyl-eicosanoic acid and/or polyalkylene glycol, as taught by Naito et al., to the composition of Decoster because of the expectation of achieving a hair care product that additionally conditions the hair and prevents it from being damaged, and/or imparts moisturization and flexibility to the hair.

Claims 1-32, 34-41 and 43-47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Decoster (English Translation of WO 97/46211) in view of Hughes (5,567,428).

The instant invention is directed toward a composition comprising a washing base comprising an anionic and amphoteric surfactant, wherein the ratio of amphoteric:anionic is greater than or equal to 0.1:1, and a conditioner system comprising at least one aminated silicone having an amine number greater than or equal to 0.5 meq/g, and a cationic polymer.

Decoster exemplifies a shampoo composition comprising 14g laurylethersulfate of sodium (anionic surfactant, 14% of composition), 1g laurylsulfate of ammonium (anionic surfactant, 1%), 4.6g cocoamidoethyl (N-hydroxyethyl, N-carboxymethyl) glycinate of sodium (amphoteric surfactant, 4.6%), 2.5 g amine silicone with an amine index of 0.5 meq/g (2.5%), 0.1g guar gum modified by chloride of 2,3-epoxypropyl trimethylammonium (cationic polymer, 0.1%), and water, wherein the ratio of amphoteric/anionic surfactant is 0.3:1. For the washing base comprising 4-50% of the composition, see pg. 6, last paragraph. For perfumes, preservatives, sequestering agents, thickeners, softeners, foam modifiers, coloring agents, moisturizers, anti-dandruff/anti-seborrheic agents, vitamins, sun filters, and suspension agents, see pg. 28, 3rd paragraph.

Art Unit: 1617

For derivatives of cellulose ethers that include quaternary ammonium groups and cationic polysaccharides, see pg. 16 (2) and (4). For cationic polymers of formula (a) of instant claim 35, see pg. 20 (10). For cationic polymers comprising 0.001-10%, see pg. 27, 1st paragraph. For a medium of water or water and alcohols, see pg. 28, 1st paragraph. For ethanol, isopropanol, and butanol, see pg. 28, 1st paragraph. For a process of washing and conditioning keratinic fibers, such as hair, see pg. 29, 3rd paragraph. The reference lacks a preferred aminated silicone and an amount of solvent.

Hughes teach topical care compositions. For compounds of formula (I) and (III) of the instant invention, see Col. 13, line 57-Col. 14, line 19. Formula (III) is the same as the compound of the formula of Col. 13, line 60, when $n=0$, $a=0$, $b=1$, $m=1$, G is CH_3 , R_1 is $(\text{CH}_2)_3\text{-NH-}(\text{CH}_2)_2\text{-NH}_2$. For compounds of formula (IV) of the instant invention, see Col. 14, lines 33-56. For the limitations of instant claims 13-25 and 27-29, see Col. 13, line 40-Col. 14, line 59. These compounds are taught as providing hair hold and style hold benefits, while imparting a softer, less stiff feel to the hair. These compounds are exemplified for use in shampoo compositions. See Col. 1, lines 16-35; Col. 15, lines 48-51; Col. 34, lines 10-45.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to substitute the aminated silicones taught by Hughes for those of Decoster because of the expectation of achieving similar aminated silicone properties in hair care formulations and because of the expectation of achieving a product that cleanses the hair, while imparting styling hold benefits that do not leave the hair feeling stiff. It is further respectfully pointed out that the substitution of one aminated silicone for another is obvious and within the skill of the artisan.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to teach the solvents of Decoster as comprising 0.1-20% of the composition because it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art (*In re Aller*, 105 USPQ 233) and because Decoster teaches his compositions in a variety of forms, such as liquids more or less thickened, creams and gels; thus, one of skill would be motivated to alter the amount of solvent in the composition to achieve specific composition forms.

Claims 33 and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Decoster in view of Hughes as applied to claims 1-32, 34-41 and 43-47 above, and further in view of Naito et al. (5,476,649).

Decoster and Hughes are applied as discussed above. The references lack 18-methyl-eicosanoic acid and polyalkylene glycols.

Naito et al. teach 18-methyl-eicosanoic acid as a branched fatty acid that imparts excellent conditioning effects to the hair and prevents the hair from being damaged, see abstract and Col. 1, lines 54-67. Polyalkylene glycols are taught as hair care ingredients that impart moisturization and flexibility to the hair.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to add 18-methyl-eicosanoic acid and/or polyalkylene glycol, as taught by Naito et al., to the composition of the combined references because of the expectation of achieving a product that conditions the hair and prevents it from being damaged, and/or imparts moisturization and flexibility to the hair.

Response to Arguments

Regarding Applicant's request for clarification, a) Decoster '747 is being relied upon as an English language equivalent of WO 97/46210; b) In the first paragraph of the 103 rejections in the previous Office Action, there were two types, wherein 0.1:1 should have been 0.2:1 and 0.5meq/g should have been 0.4meq/g. Regarding the exemplification of Decoster '747, see the above rejection, wherein the appropriate corrections were made to reflect the exemplification of Decoster '747.

Regarding the surfactant ratio, Applicant argues, "Since no other evidence of this ratio is taught or suggested, this limitation has not been met". This argument is not persuasive. In Col. 20, Example 1 of Decoster, a composition is exemplified, wherein amphoteric surfactant comprises 3.2% of the composition and anionic surfactant comprises 14% of the composition, thus resulting in a ratio of 0.23, which meets the instant limitations.

Applicant argues, "Even if the Examiner relied on the Decoster '744 teachings of monomerically similar aminosilicones, the Examiner has provided no evidence or explicit teaching of the instantly claimed amine number, which, in part, defines the relative amounts of the monomeric components of the polymer". This argument is not persuasive. Decoster teaches the exact same compounds as those recited in the instant claims, wherein each of the resulting amines are taught as equivalent for use in Decoster's compositions. Thus, while Decoster does not explicitly state the amine number, since the compounds being taught are the same as those recited in the instant claims, and since a compound and its properties are inseparable, the compounds of Decoster have an amine number of greater than or equal to 0.4meq/g.

Art Unit: 1617

Applicant argues, “this amounts of improper picking and choosing among the amine numbers without any reason given by the Examiner for guidance on which amine numbers to choose”. This argument is not persuasive. As stated in previous Office Action, and the above paragraph, Decoster teaches their amines as equivalent for use in their compositions, wherein Decoster specifically teaches the compounds formulated in the instant claims. Thus, substituting one for the other, given the teachings of Decoster, is within the skill of the artisan.

Applicant argues, “the solvent amount has not been properly identified as a result-effective variable, and (b) Applicants have at least three parameters that had to be correctly chosen”. This argument is not persuasive. First, it is respectfully pointed out that the instant independent claims do not require a solvent, let alone a specific amount of solvent. Second, as pointed out in the above rejections, Decoster et al. themselves specifically teach broad formulations (i.e., liquid to cream), thereby implying that the amount of solvent is variable and within the skill of the artisan to adjust dependent on the type of cosmetic formulation the composition embodies. Regarding, Applicant’s second point, it is respectfully pointed out that the instant rejections are 103 rejections, wherein the references are applied for what they make obvious to one of ordinary skill in the art and not what they exemplify. For reasons of record, it is the Examiner’s position that there is motivation to rely on the teachings of Decoster to arrive at the instant invention. It is lastly pointed out that the test for obviousness is the reference or combination of references makes obvious to one of ordinary skill in the pertinent art.

Applicant argues, “Specifically DC 939 and Q2 7224 are the only aminated silicones mentioned explicitly or used in the examples, and both are non-transparent”.

Art Unit: 1617

This argument is not persuasive. First, it is respectfully pointed out that it is well established that consideration of a reference is not limited to the preferred embodiments or working examples, but extends to the entire disclosure for what it fairly teaches when viewed in light of the admitted knowledge in the art, to person of ordinary skill in the art. In re Boe, 355 F.2d 961, 148 USPQ 507, 510 (CCPA 1966); In re Lamberti, 545 F.2d 747, 750, 192 USPQ 279, 280 (CCPA 1976); In re Fracalossi, 681 F.2d 792, 794, 215 USPQ 569, 570 (CCPA 1982); In re Kaslow, 707 F.2d 1366, 1374, 217 USPQ 1089, 1095 (Fed. Cir. 1983). See the above rejections, wherein the transparency limitation is addressed.

Applicant argues, “the motivation for choosing the amino silicone subgenus of claim 47 from the cited references is absent, as is the motivation to simultaneously use an amount of the washing base in the claimed range with its surfactants in the claimed ratio”. This argument is not persuasive, and has been addressed in the previous paragraphs.

Applicant argues, “It is not stated where polyalkylene glycols are mentioned in Naito, nor where this motivation can be found”. This argument is not persuasive. See the “Summary of Invention”.

Applicant argues, “Regarding the 18-methyl-eicosanoic acid, the Examiner has selected a single species from an exceedingly broad genus. According to Naito, the fatty acid formula (1) provides chemical variations that exceed 10,000 chemicals”. This argument is not persuasive, as 18-methyl-eicosanoic acid is specifically exemplified.

Applicant argues, “the Hughes adhesive polymer provides the stated ‘holding’ and ‘fasting’ properties, not the aminated silicone. . .Also, the Office Action recites no

Art Unit: 1617

teaching in Decoster '211 as to its purpose for using an aminated silicone". This argument is not persuasive. First, it is respectfully pointed out that Decoster '211 teaches their aminated silicones as an ease of styling, volume, and lightness, see page 29 of the translation. Second, Hughes specifically teaches the aminated silicones as increasing style hold strength in Col. 11.

Applicant argues, "The Examiner appears to be relying on substituting equivalents known for the same purpose, but such equivalency must be recognized in the prior art, and cannot be based on that fact that members are part of the same Markush group". This argument is not persuasive. As pointed out in the above paragraph, aminated silicones are known for the same purpose in both Decoster and Hughes.

Applicant's additional arguments were addressed by the Examiner in response to the first 103 rejection.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the

Art Unit: 1617

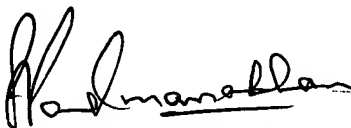
advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lauren Q Wells whose telephone number is 571-272-0634. The examiner can normally be reached on M&R (5:30-4).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on 571-272-0629. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Lqw


SREENI PADMANABHAN
SUPERVISORY PATENT EXAMINER